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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,760	12/13/2000	Kazuo Watanabe	SONY-U0200	6661

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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/735,760	Applicant(s) WATANABE, KAZUO	
	Examiner Michael Pyzocha	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-5, 7-11, and 13-14 are pending.
2. The amendment of 09/07/2004 has been received and considered.

Claim Rejections - 35 USC § 112

3. In view of the amendments to claims 5 and 11, and the cancellation of claims 6 and 12, the rejections un 1st and 2nd paragraph made in the previous Office action are hereby withdrawn.

Claim Objections

4. In view of the Applicant's arguments, the objection to the claims made in the previous Office action is hereby withdrawn.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-5, 7-11, 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen (US pat 5,758,069), and further in view of Uchenick (US pat 4,458,315).

Regarding claim 1, Olsen teaches a method of managing software use by a software provider for distribution to a user, comprising the steps of: encoding second information by using a first key of a key pair of an open key encoding format (col. 10 lines 12-26); and transmitting the encoded second information to said software user for said software user to decode said transmitted encoded second information by using a second key of said key pair of said open key encoding format (col. 10 lines 12-26, where a digital signature is used to transmit and decode encoded information and col. 12 lines 33-44).

What Uchenick teaches that Olsen doesn't teach is storing inside the software predetermined first information (col. 2 lines 1-8); providing the software to a software user on an information storage means (col. 1 line 67, col. 4 lines 2-4 and 46-51) prepared corresponding to the software and to be connected to an apparatus for running the software, which information storage means is capable of being accessed by the apparatus in a connected state (col. 2 lines 38-43, col. 2 lines 58-60); and to read said first information from said information storage means, and to match said read first information against

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said decoded second information, wherein said software is enabled when the information match (col. 2 lines 9-16).

It would have been obvious to one of ordinary skill in the art to combine Olsen's electronic licensing system with Uchenick's method for preventing unauthorized use of computer programs in order to provide a more adequate and reliable means of preventing copying of unauthorized use of computer programs, and particularly provide a means which does not depend on the good faith of the licensee for its success (Uchenick col. 1 lines 52-57).

Regarding claim 2, Olsen and Uchenick teach a method of managing software use as set forth in claim 1, in addition Olsen teaches receiving predetermined third information identifying the software provided along with said software and said information storage means from the user when said user seeks authorization of use of said software (col. 8 line 64 thru col. 9 line 3, col. 11 lines 33-35); identifying said software user based on said transmitted third information; and detecting second information to be matched against said first information stored in said information storage means given to the software user (col. 11 lines 21-48); detecting second information to be matched against said first information stored in said

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information storage means given to the software user (col. 11 lines 21-48, col. 12 lines 7-19).

Regarding claim 3, Olsen and Uchenick teach a method of managing software use as set forth in claim 2, in addition Olsen teaches said first information and said second information are selected from the group of information consisting of identification information for identifying said software user, identification information for identifying said distributed software, and identification information for identifying said information storage means (col.5 lines 20-64, col. 9 lines 22-38, col. 10 lines 26-30).

Regarding claim 4, Olsen and Uchenick teach a method of managing software use as set forth in claim 3, in addition Olsen teaches said first and second information is a password added to said software and said information storage means (col.5 lines 35-42).

Regarding claim 5, Olsen and Uchenick teach a method of managing software use as set forth in claim 3, in addition Olsen teaches the step of configuring the software such that processing for controlling said software use is performed each time said software user uses said software (col. 8 lines 28-42).

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Claims 7,13, and 14 are substantially equivalent to claim 1; therefore claims 7,13, and 14 are rejected because of similar rationale.

Claims 8-11 are substantially equivalent to claims 2-7 respectively, therefore claims 8-12 are rejected because of similar rationale.

Response to Arguments

7. Applicant's arguments filed 09/07/2004 have been fully considered but they are not persuasive.

Applicant argues the rejection of independent claims 1, 7, 13 and 14 under Olsen in view of Uchenick fails to disclose storing first information in the software; transmitting a second information to the software user, decoding the second information using a second key, reading first information, and matching the first information against second information; providing a software on an information storage means that is connected to an apparatus to run the software; transmitting a second key to the user; transmitting a second key to a user where it is decoded and matched to a first key.

Regarding the argument stating Olsen in view of Uchenick fails to disclose storing first information in the software, the

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applicant argues that Olsen fails to disclose said limitation.

Uchenick teaches said limitation as in column 2 lines 1-8.

Regarding the argument that Olsen in view of Uchenick fails to disclose transmitting a second information to the software user, decoding the second information using a second key, reading first information, and matching the first information against second information the Applicant is directed to Olsen's use of a digital watermark in column 10 which has a purpose to decode and compare two pieces of information.

Regarding the argument that Olsen in view of Uchenick fails to disclose providing software on information storage means that is connected to an apparatus to run the software; Applicant is further directed to column 4 lines 2-4 and 46-51 of Uchenick which more clearly state this limitation.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., transmitting a second key to the user; transmitting a second key to a user where it is decoded and matched to a first key) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP



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